

REMARKS

Reconsideration of the present patent application is respectfully requested.

In the Office Action dated March 29, 2005, all pending claims have been rejected (non-final). More specifically, claims 19, 2-8, 11-17, 20, and 22-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Biancalana et al. Claims 10 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Biancalana et al. as applied above and further in view of Gaydoul et al. Further, the Examiner has raised a 35 U.S.C. §112 issue regarding claims 20 and 25 and in particular the use of the phrase "industrial grade". Claims 20 and 25 have been amended so as to remove the objectionable language.

In terms of the rejection of the claims based on the Biancalana patent, independent claim 19 recites, among other features and relationships, a "cleaning" solution comprising a mixture of compressed air and alcohol. The Biancalana reference describes its "cleaning" solution as comprising pressurized air and water, see column 3, lines 34-44.

The Examiner considers that Biancalana discloses all limitations of claim 19 with the exception of alcohol. It is then suggested that the use of alcohol as a disinfectant agent would be a matter of obvious design choice.

Applicant disagrees with this characterization of the Biancalana patent. First, Biancalana does not offer any suggestion of replacing the water that is used in its "cleaning" solution with any type of disinfectant agent. Even if one would concede that alcohol is known as a disinfectant, the starting point for this discussion is whether there is

Amendment Response
Serial No. 09/942,317 Group Art Unit 1746
Atty. Docket No. 8016-548/8-02-12208
Page 7 of 11

any suggestion in Biancalana of replacing the water in the "cleaning" solution with a disinfectant agent. The undersigned counsel of record did not find any mention in Biancalana of this substitution. Without some suggestion of this preliminary and basic substitution, we never get to the question of whether it is obvious to use alcohol as a disinfectant agent in this type of device.

If the Examiner gives the foregoing explanation proper consideration, it will be quite clear that nothing in Biancalana suggests replacing the water of its "cleaning" solution with some other substance. Equally important in the analysis of the Biancalana patent is the fact that it does use a disinfectant agent for the purpose of the disinfection and the drying of the instrument in chamber 4, see column 4, lines 10-14. However, the Biancalana method of choice is to use one set of nozzles 10 for "cleaning" and a second, separate, and different set of nozzles 11 for the disinfection and the drying.

Even though Biancalana clearly states that it wants to perform the functions of cleaning, disinfection, and drying, it also just as clearly and forcefully states that it must do this through two different, separate sets of nozzles. One set of nozzles is for water and air for "cleaning" and the other separate set of nozzles is for air and a disinfectant agent for the disinfection and drying.

It is also important for the Examiner to recognize, as is reinforced by Biancalana, that "cleaning" is removal of particulate matter, dirt, debris, etc. The disinfecting is different and, in terms of the Biancalana patent, comes after the initial cleaning. As Biancalana states, there are three different aspects involved in this overall process. There are the steps of cleaning, disinfecting, and drying and the obvious fact that these three are separately listed in the Biancalana patent clearly confirms that they are separate and

Amendment Response
Serial No. 09/942,317 Group Art Unit 1746
Atty. Docket No. 8016-548/8-02-12208
Page 8 of 11

distinct activities. This at least is how Biancalana views these functions and went to fairly elaborate steps in terms of the overall mechanism to make sure that these various steps were performed as separate, independent, and distinct activities. Applicant, on the other hand, has found a way to combine the cleaning and disinfecting functions and thereby reduce the complexity of the device and reduce overall costs. A further benefit of Applicant's approach with its claimed device is the reduction of fluidic waste as previously noted.

Nothing in Biancalana would suggest to anyone of ordinary skill in the art the use of alcohol in lieu of water for "cleaning". In fact, Biancalana teaches just the opposite. Whenever the references cited by the Examiner teach in the opposite direction, this then becomes extremely powerful and in effect conclusive evidence that claim 19 is both novel and unobvious. When the primary reference relied upon by the Examiner provides a structure and mixture for "cleaning" and an entirely different structure and mixture for disinfecting and drying, there is nothing in that reference to suggest Applicant's claimed structure.

The benefits derived from a single set of nozzles, as claimed by the Applicant, are clear. As such, one can only assume that if the Biancalana inventors even considered using a disinfectant for cleaning, they were unable to create a properly functioning device. The fact that the Biancalana reference makes absolutely no mention of using a disinfectant agent for the cleaning step suggests that the Biancalana inventors never considered that possibility and went in an entirely different direction. This is further confirmation that Applicant's claims are novel and unobvious.

There is a final thought in terms of the amount of fluidic waste for the Examiner to consider. Since the Applicant uses alcohol for the combined cleaning and disinfecting step, there is in effect not only a single solution, but also a solution composition that evaporates more rapidly than water. Biancalana, on the other hand, actually magnifies the problem of fluidic waste by first using water for cleaning and then adding more fluid into the overall process by the second and separate addition of the disinfectant agent. Even if alcohol is used as the disinfectant agent, something which is not disclosed in Biancalana, the initial volume of water used for cleaning all ends up as fluidic waste. You then add to this volume the portion of the disinfectant agent that gets flushed away prior to any evaporation.

Claim 24 recites a different structural composition for the claimed apparatus, as compared to claim 19, such as the addition of the mixer for intermixing the compressed air with alcohol for the "cleaning" solution. While Biancalana mentions an atomizing unit, it is not used to create a "cleaning" solution. Consequently, the use of this mixer for creating the cleaning solution is a reason for the patentability of claim 24. Another reason for the patentability of claim 24 is that it recites the use of alcohol for its cleaning solution. Therefore, the remarks regarding the Biancalana patent in terms of its "non"-use of alcohol for "cleaning" apply with full force and effect for claim 24.

Claim 26 includes elements of claims 19 and 24 and is believed to recite a patentable structure in terms of these elements. However, claim 26 also recites the use of alcohol for its cleaning solution. As such, the remarks already provided with regard to the Biancalana patent in terms of its non-use of alcohol for "cleaning" apply with full force and effect for claim 26.

Amendment Response

Serial No. 09/942,317 Group Art Unit 1746

Atty. Docket No. 8016-548/8-02-12208

Page 10 of 11

Based upon the analysis of Biancalana and the explanation offered with regard to the patentability of independent claims 19, 24, and 26, claims 2-8, 10-17, 19, 20, and 22-30 are in condition for allowance and are respectfully requested to be passed to issue.

Respectfully submitted,

By

James M. Durlacher
James M. Durlacher, Reg. No. 28,840
Woodard, Emhardt, Moriarty,

McNett & Henry LLP

Bank One Center/Tower

111 Monument Circle, Suite 3700

Indianapolis, Indiana 46204-5137

(317) 634-3456

Amendment Response

Serial No. 09/942,317 Group Art Unit 1746

Atty. Docket No. 8016-548/8-02-12208

Page 11 of 11